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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,813	10/30/2003	Donald H. Osterberg JR.	021756-067000US	2479
51206 7590 10/01/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER WHIPPLE, BRIAN P				
ART UNIT		PAPER NUMBER		
2452				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,813

Applicant(s)

OSTERBERG, DONALD H.

Examiner

BRIAN P. WHIPPLE

Art Unit

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-2, 5-9, and 21-27 are pending in this application and presented for examination.

Response to Arguments

2. Applicant's arguments filed 5/20/09 have been fully considered but they are not persuasive.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant cites a block of text, that in addition to including amended subject matter, that is rejected by a combination of references and then alleges each reference individually fails to teach the subject matter. Namely, the subject matter was rejected largely by Kaminski, but "the authorization indicator is sent after authorization" was rejected by Quine.

Additionally, Applicant generally claims the subject matter is not taught by the references, but fails to disclose how the subject matter is not taught in relation to the sections of the prior art relied upon. For example, the subject matter discussed is mainly rejected by

Kaminski, as discussed in the preceding paragraph, but Applicant fails to compare the subject matter to the cited sections of Kaminski. Therefore, the rejection is maintained in the absence of any substantive comparison to the cited sections of the prior art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, 5-9, and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski et al. (Kaminski), U.S. Publication No. 2005/0044155 A1, in view of Goldman, U.S. Publication No. 2003/0233418 A1, and further in view of Quine et al. (Quine), U.S. Publication No. 2002/0023138 A1.

6. As to claim 1, Kaminski discloses an unsolicited e-mail internet protocol source address verification method (Abstract, ln. 1-3) comprising:

receiving at an e-mail authorization system a request for authorization to forward an electronic mail message, the request identifying an address of a source of said request ([0032], ln. 1-2; [0034], ln. 1-4 and 9-15);

responding with the e-mail authorization system to the address of the source of the request to said request for authorization to forward said electronic mail message ([0035], ln. 1-3 and 8-10), wherein a response to said request for authorization includes an authorization indicator that indicates the source of said request for authorization ([0036], lines 10-12), wherein the authorization indicator is sent from the e-mail authorization system to the address of the source request([0036], ln. 10-12) ; and

handling receipt of said electronic mail message at a destination (Fig. 10, item 450).
Kaminski is silent on the authorization indicator is sent after authorization; and
verifying the source address included in the received said electronic mail message against the address the authorization indicator is sent to.

However, Goldman discloses verifying the source address included in the received said electronic mail message against the address the authorization indicator is sent to ([0063]; the purported address is verified against itself or the manager's address through the use of an authorization request for indicating authorization).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski by verifying the source address of an

electronic mail message against the given address or a manager's address as taught by Goldman in order to detect spoofed sender addresses, the occurrence of which typically indicates junk e-mail (Goldman, [0063], lines 11-14) and/or allow a manager to control whom is classified as unauthorized in a mail system (Goldman: [0063]).

Kaminski and Goldman are silent on the authorization indicator is sent after authorization.

However, Quine discloses the authorization indicator is sent after authorization ([0101] – [0102]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski and Goldman in the aforementioned manner as taught by Quine in order to indicate a change, related to email addressing, to authorized users (Quine: [0101]).

7. As to claim 2, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including said request is initiated by a source of said electronic mail message (Kaminski: Figure 7, item 258 of SENDER'S MAIL CLIENT 14; [0034], lines 9-15) and

said request asks a simple mail transfer protocol agent of the e-mail authorization system for authorization to send an electronic mail message to a destination serviced by said simple mail transfer protocol agent (Kaminski: [0036], lines 1-4).

8. As to claim 5, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including performing at the email authorization system an indication generator process in which an authorization indicator is generated (Kaminski: Figure 7, item 268; [0036], lines 10-12).

9. As to claim 6, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 5, including said authorization indicator is a unique bit string and further identifies the email authorization system (Kaminski: [0036]; [0038]; [0044], lines 1-3; [0045], lines 8-11).

10. As to claim 7, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including tracking said source address with the e-mail authorization system (Kaminski: [0036], lines 4-9).

11. As to claim 8, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 2, including inserting an entry into said electronic mail message with the simple mail transfer agent indicating the address the authorization indicator is sent to before forwarding said electronic mail message from the e-mail authorization system to the destination (Kaminski: [0036], ln. 1-4; [0046], lines 13-20).

12. As to claim 9, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including extracting a request source address from said request (Kaminski: [0034], lines 9-15; [0035], lines 1-3); and

utilizing said request source address as a destination address in a header file of a return package including authorization indicator information (Kaminski: [0022], lines 20-23; [0025], lines 3-4; [0035], lines 1-3; [0036], lines 10-12).

13. As to claims 21-22 and 25, the claims are rejected for reasons similar to claim 1 above.

14. As to claim 23, the claim is rejected for reasons similar to claim 2 above.

15. As to claim 24, the claim is rejected for reasons similar to claim 8 above.

16. As to claim 26, the claim is rejected for reasons similar to claim 6 above.

17. As to claim 27, the claim is rejected for reasons similar to claim 7 above.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (11:30 AM to 6:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
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Examiner, Art Unit 2452
9/28/09

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